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10/562,499

05/30/2006

Eugenio Ferreira Da Silva Neto

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

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2863

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 10/562,499 | Applicant(s) DA SILVA NETO, EUGENIO FERREIRA | |
| | Examiner Edward R. Cosimano | Art Unit 2863 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9,11-13 and 15-17 is/are pending in the application.
4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 is/are allowed.
- 6) ☒ Claim(s) 9,11-13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2863

1. When preparing this Office action the examiner has consider the instant application to include:

- A) the Oath/Declaration filed on 30 May 2006;
- B) the amended Abstract filed on 30 May 2006;
- C) figures 1 & 2 of the set of drawings containing 1 sheet of 2 figures comprising figures 1 & 2 as presented in the set of drawings filed on 25 June 2007;
- D) the written description as filed on 30 May 2006 and amended on 30 May 2006 and on 13 March 2008; and
- E) the set of claims as filed on 13 March 2008.

2. Applicant's claim for the benefit of an earlier filing date pursuant to 35 U.S.C. 120 is acknowledged.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

4. The examiner has considered the prior art cited in the base applications.

5. The Oath/Declaration filed on 30 May 2006 and the amended Abstract as filed on 30 May 2006 are acceptable to the examiner.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.1 Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1.1 In regard to claim 16, as one of ordinary skill at the time the invention was made would fairly and reasonably interpret the language used in this claim to define claimed invention, the recited invention is merely directed to a cable with an attached "chip-tag" that functions to store device specific data/information about a field device. However, further it is noted that one of ordinary skill at the time the invention was made would fairly and reasonably recognize from the language used to define the claimed invention that:

- A) the cable alone, that is without the recited memory, would achieve the function of a "connecting cable" that connects the "field devices" to the "field bus" as recited in

the preamble. Further since one of ordinary skill at the time the invention was made would reasonably recognize that the recited structure of an attached memory that functions to “store device specific data/information” does not aid the remaining structure of a connecting cable in performing the function of connecting the “field devices” to the “field bus”, then one of ordinary skill at the time the invention was made would be confused by what function is provided by the recited “chip-tag” relative to the remainder of the invention so that the invention as a whole would function as a single invention that would achieve and provide the useful and beneficial function of a connecting cable because the chip-tag or memory is not required or used in order to achieve and provide function of a connecting cable.

B) applicants use of the phrase “field devices” in the preamble and body of claim 16 would clearly lead one of ordinary skill at the time the invention was made to fairly and reasonably believe that there is more than one field device that may be connected to field bus via the recited “connecting cable” and that the attached chip tag that functions to “store device specific data/information”, then one of ordinary skill at the time the invention was made would be confused by what function is provided by the recited “chip-tag” relative to the remainder of the invention so that the invention as a whole would function as a single invention that would achieve and provide the useful and beneficial function of a connecting cable because the chip-tag or memory is not required or used in order to achieve and provide function of a connecting cable.

C) because the attached chip tag that functions to “store device specific data/information” about more than one “field device”, then one of ordinary skill at the time the invention was made would be confused by what function is provided by the recited “chip-tag” relative to the remainder of the invention so that the invention as a whole would function as a single invention that would achieve and provide the useful and beneficial function of a connecting cable because the chip-tag or memory is not required or used in order to achieve and provide function of a connecting cable.

Therefore, applicant has failed to particularly point out and distinctly claim the invention.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7.1 Claims 9, 11-13, 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Pickett (4,949,299) or Beaverstock et al (5,134,574) or Warrior et al (5,485,400 or 5,825,664) or Sugihara et al (6,035,247) as applied above to claims 9 & 15 and further in view of either Palmer et al (5,530,702) or Oba et al (2004/0248617).

7.1.1 In regard to claims 9, 11-13 & 15, either Pickett ('299) or Beaverstock et al ('574) or Warrior et al ('400 or '664) or Sugihara et al ('247) disclose a machine/process that provides the useful and beneficial function of a distributed control communications network. In these machines/processes one or more uniquely identified computer implemented field devices units or field distribution devices, are connected to a central unit via a common communications bus or "field bus" by using a common communications protocol (note claim 15) in order to exchange and distribute data/information between the field devices and the central unit. Further, in these machines/processes, the field distribution unit performs the functions of receiving a control command via the common bus from the central controller unit and then based on the received command performs the function of functions that are associated with the received command. As taught by either Pickett ('299) or Beaverstock et al ('574) or Warrior et al ('400 or '664) or Sugihara et al ('247), the functions that maybe perform include at least the functions of:

A) transmitting of data/information from a memory in the field distribution to the central controller, where the transmitted data/information includes an unique device specific identifier for the transducer;

B) controlling the operation of one or more of the transducers that are connected to the field distribution unit to make measurements; or

C) controlling the operation of one or more of the transducers that are connected to the field distribution unit by setting control points for the transducers.

Art Unit: 2863

7.1.2 It is noted that neither Pickett ('299) nor Beaverstock et al ('574) nor Warrior et al ('400 nor '664) nor Sugihara et al ('247) disclose the use of an attached RF ID chip-tag to store device specific data/information about an associated item and the use of an tag reader, however, it is noted that in the environment of storing and transmitting device specific information either Palmer et al ('702) or Oba et al ('617) disclose a clear teaching or suggestion of a machine/process that provides the useful and beneficial function of using an attached RF identification tag in order to perform the functions of:

A) storing device specific identification data/information about the attached device; and

B) transmitting the stored device specific identification data/information when requested by an appropriate RF tag reader.

Since the operation of the machines/processes of either Pickett ('299) or Beaverstock et al ('574) or Warrior et al ('400 or '664) or Sugihara et al ('247) requires the use of:

A) some type of memory device in order to perform the function of storing device specific identification data/information; and

B) the transmission of device specific data/information to a remote device; and

C) either Palmer et al ('702) or Oba et al ('617) discloses that it is known to use a RF identification tag that is attached to an item is used to transmit stored identification data/information about the item to a reader when required;

then it would have been obvious to one of ordinary skill at the time the invention was made that the machines/processes of either Pickett ('299) or Beaverstock et al ('574) or Warrior et al ('400 or '664) or Sugihara et al ('247) could be modified to use RF ID tags to perform the functions of to storing identification data/information about an item and when requested to transmit the stored data/information as taught by either Palmer et al ('702) or Oba et al ('617). In this regard it is noted that the application or use of a known process/machine to another machine/process or a variation of the machine/process for the same purpose to achieve the same results is deem obvious, note KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) 127 SCt 1727.

7.1.3 In regard to claim 16, it is noted that since either Palmer et al ('702) or Oba et al ('617) provide a teaching/suggestion that the item that is associated with the RFID tag could be any

item with the RF tag suitably placed on the item, it would have been further obvious to one of ordinary skill at the time the invention was made that the machines/processes of either Pickett ('299) or Beaverstock et al ('574) or Warrior et al ('400 or '664) or Sugihara et al ('247) as modified to use RF ID tags could be applied to any suitable part of the item, for example a communication adapter/interface port, etc. In this regard it is noted that the application or use of a known process/machine to another machine/process or a variation of the machine/process for the same purpose to achieve the same results is deemed obvious, note KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) 127 SCt 1727.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Response to applicant's arguments.

9.1 The objections and rejection that have not been repeated here in have been overcome by applicant's last response.

9.2 How Claims are to be interpreted during the prosecution of an application for patent.

9.2.1 The pending claims are interpreted by giving the language of every positively recited limitation of the pending claims the broadest reasonable interpretation that is consistent with how one of ordinary skill at the time of the invention would have interpreted the language of the claims, In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999), while (1) taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification, In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), and (2) without reading unrecited limitations from applicant's disclosure into the claims, see In re PRATER AND WEI, 162

USPQ 541 at 551 (CCPA 1969) “We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim.”, In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969).

9.2.2 Further, when interpreting the claims as a whole, then the interactions of claim limitations as a whole must be considered in order to determine the scope of a claim and the applicant’s contribution in the art, In re LARSEN, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) “The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor’s contribution to the art.”. Where a statutory process/machine must contain an operative series of acts/functions or structures, In re MUSGRAVE, 167 USPQ 280 at 289-290 (CCPA 1970), with explicitly recite all of the necessary interactions to accomplish the recited utility of the claimed invention, for without these interaction the claim as a whole would not be a proper process/machine under the statute, In re SARKAR 200 USPQ 132 at 136 (CCPA 1978).

9.2.3 In regard to the limitations on the interpretation of the claimed invention as imposed by the Court, because it is noted that applicant has gone to great lengths in the written description to describe each of the claimed structures or actions recited in the limitations of the claimed invention by using a written description that:

A) does not describing a specific structure or a specific action to provide a recited function; and

B) merely describing the claimed structures or actions by describing the function of each of the claimed structures or actions;

then, it is noted that as set forth by the Court each of the limitations of the claims would be reasonably interpreted by one of ordinary skill at the time of the invention as not being not limited solely to the structures or actions that would correspond to the written description of the claimed structures or actions. Therefore, in fact the limitations of the claims would to be broadly interpreted by one of ordinary skill at the time the invention was made to include any and all structures or actions that would provide the corresponding functions that have been recited for the structures or actions that are recited in the limitations of the claimed invention.

Art Unit: 2863

9.2.4 As a final note, although it is conceivable that one of ordinary skill may know many different actions/structures that would achieve the functions of the structures and actions recited as claimed invention, since the claims fail to positively recite the actual structures or actions that are used in the claimed invention, then one of ordinary skill at the time the invention was made would have recognized that any type of structure or action that would achieve the recited function could be used without being limited to the disclosed structures and/or actions that are not recited and therefore may not be attributed to the claimed invention.

9.3 In regard to the rejection of claim 16 under 35 U.S.C. 112 2nd paragraph and the rejection of claims 9, 11-13, 15 & 16 under 35 U.S.C. 103, applicant's arguments are deemed non-persuasive and this rejection has been maintained in view of the respective modified rejection as set forth above and the following considerations.

9.3.1 In regard to applicant's arguments regarding the nature of the subject matter recited as the invention and the functions/acts that as recited in the claims are performed by the instant invention. It would appear that applicant has not considered what the knowledge of one of ordinary skill would be regarding the claimed invention, how one of ordinary skill would interpret the limitations of the claimed invention, and has read constraining limitation from the disclosure into the claims, which is a practice that the Court has instructed the Patent Office not to do, see In re PRATER AND WEI, 162 USPQ 541 at 551 (CCPA 1969).

9.3.2 In regard to the rejection of claim 16 under 35 U.S.C. 112 2nd paragraph, because:

A) applicant has not provided any arguments regarding what applicant believes the invention of claim 16 to be; and

B) applicant's arguments appear to be based solely on unclaimed distinctions and merits that do not appear in the language of the claims as a positively recited limitation of the claimed invention;

the argued merits and distinctions may not be attributed to the claimed invention and applicant's arguments are deemed non-persuasive.

9.3.3 In regard to the rejection of claims 9, 11-13, 15 & 16 under 35 U.S.C. 103, applicant's arguments are deemed non-persuasive and this rejection has been maintained in view of the respective modified rejection as set forth above and the following considerations.

Art Unit: 2863

9.3.4 In regard to distinguishing the invention recited as a machine in claims 9, 11-13 & 15 and as an article/machine in claim 16 from the teachings/suggestions of the applied prior art. It is noted that claims 9, 11-13, 15 & 16 recite a machine as the claimed invention and therefore must be distinguished over the prior art by the structure recited as the claimed invention and not the functions/acts performed by the claimed invention, see MPEP sections 2111, 2112 & 2114.

9.3.5 With the above in mind, because one of ordinary skill at the time the invention was made would reasonably interpret the language used in the limitations of the pending claims, as provided by the non-limiting guidance of applicant's disclosure, to include any and all structures/actions that could perform the functions that are recited as the invention. Therefore, the machine of claims 9, 11-13 & 15 or the manufacture/article of claim 16, as recited in the pending claims would merely convey to one of ordinary skill at the time the invention was made that applicant has merely recited:

A) a preamble that recites a non-limiting intended field of use for the process/structure of claims 9, 11-13, 15 & 16, since what is recited as the preamble would not be recognized as imparting any limiting action/structure to what is described in the body of the claim and hence does not go beyond a statement of the intended field of use of the claimed invention, see MPEP sections 2111, 2112 & 2114.

B) a series of one or more actions/structures in claim 9, 11-13, 15 & 16 that are set forth by merely reciting a name and one or more associated actions/functions without reciting the specific details of how each of the recited actions/functions are to be performed by the recited invention and hence, the claims fail to positively recite a limitation that would restrict what one of ordinary skill at the time the invention was made would recognize as the structure/action that is used to perform the recited function beyond any structure/action that would perform the recited acts/functions. Therefore, one of ordinary skill at the time the invention was made would recognize that these limitations would be interpreted as merely conveying/imparting that an unspecified someone or something is to perform one or more actions/functions in an unspecified manner, see MPEP sections 2111, 2112 & 2114.

Art Unit: 2863

9.3.6 In view of the above and as set forth above in the rejection the examiner's use of the applied prior art would be clearly recognized by one of ordinary skill in the art at the time the invention was made as:

A) providing a teaching or suggestion of every action/structure to perform the one or more functions that are recited as the invention in a manner that is consistent with how one of ordinary skill at the time the invention was made would have interpreted both: (1) the instant claims and disclosure, and (2) the teachings of the prior art with the aid of any guidance provided by the instant disclosure.

Where contrary to applicant's arguments, the applied prior art would teach or suggest what would be clearly recognized by one of ordinary skill in the art at the time the invention as being what is recited as the claimed invention regardless of whether or not:

A) that the purpose of the prior art is different than what is disclosed/claimed; or

B) the manner in which data/information that is processed/displayed in the prior art different than what is disclosed.

It noted that as set forth in MPEP 2123(II) the mere fact that an invention that contains of the recited structures or process acts, see above, but is for a different purpose does not render the claimed invention as either not "anticipated" or "unobvious" in view of the applied prior art. Further, it is noted that the data/information that is processed/displayed as recited in machine claims 9, 11-13, 15 & 16 does not affect the operation of the structures that are recited as the invention in machine claims 9, 11-13, 15 & 16. Hence the data/information that is process and displayed is "non-functional descriptive material" that may not be used to render a claimed invention that otherwise is either "anticipated" or "obvious" as either not "anticipated" or "unobvious", see "Cf. In re GULACK, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).".

9.3.7 From the above discussion and in view of the fact that:

A) applicant has failed to provide any argument regarding what applicant believes the invention to be;

B) applicant has not argued how the claimed invention is distinguishable over the prior art; and

C) applicant has not provided any argument that the examiner has some how misinterpreted or applied the prior art;
applicant's arguments are non persuasive.

10. The following is a statement of reasons for the indication of allowable subject matter over the prior art:

A) however, the prior art does not fairly teach or suggest in regard to claim 17 a machine in claim 17 that provides the useful and beneficial function of a distribution unit that functions as an interface between a field device and a field bus by providing structures in claim 17 that perform at least the function of:

(1) using a microcontroller/microprocessor that is connected between a field device and a field bus as a distribution unit in order to perform the function of communicating field device specific data/information including an identification of the connected field device; and

(2) using a GPS (Global Positioning System) module that is connected to the microcontroller/microprocessor to perform the function of providing GPS location specific information from a GPS module to the microcontroller/microprocessor;

as described in the written description.

11. The examiner has cited prior art of interest, for example:

A) Shoup et al (4,831,558) discloses a machine/process that provides the useful and beneficial function of distributed data/information collection and control network in which one or more uniquely identified intelligent transducer devices are connected to a central unit via a common communications bus through the use of a common communications protocol. In this machine/process any one or more of the at least one transducer will perform a function that is indicated by a control command that has been received over the common bus from the central controller, where the control command may instruct the transducer unit to acquire and/or transmit of data/information from the transducer to the central unit where the transmitted data/information includes an unique identifier for the transducer.

Art Unit: 2863

B) either Yamazaki (2005/0027828) or Ashwood Smith (6,968,994) disclose a machine/process that provides the useful and beneficial function of using a RF identification tag that has been attached to an item transmit stored identification data/information about the item to a reader.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward R. Cosimano whose telephone number is 571-272-0571. The examiner can normally be reached on 571-272-0571 from 7:30am to 4:00pm (Eastern Time).

12.1 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow, can be reached on 571-272-2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

12.2 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ERC
05/21/2008

**/Edward Cosimano/
Primary Examiner Unit 2863**